

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-9 and 11 are pending in the application, with claim 1 being the independent claim. Claims 8 and 9 are withdrawn, and claim 10 is cancelled without prejudice to or disclaimer of the subject matter therein. The subject matter of claim 4 is presented in independent form as a new independent claim 11. New claim 11 recites the features of original claims 1, 3 and 4. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Examiner interview of August 24, 2011

Applicants thanks Examiner Son T. Nguyen for the courtesy of a telephone interview held with Applicant's representative, Anbar Khal, on August 24, 2011, regarding the present application. During that interview, the claim objections and rejections under 35 U.S.C. § 112 and 103 were discussed. The Examiner's Interview Summary (Form PTOL-413) mailed by the U.S. Patent & Trademark Office on August 25, 2011, embodies the substance of the interview.

Objection of Claim 4 and Request for Withdrawal of Finality

The Examiner continues to object to claim 4 as being in improper form on the basis that a multiple dependent claim cannot depend from any other multiple dependent claim. *See* Office Action, page 2. The Examiner has not further treated this claim on the merits. As previously explained in Applicants' Response to the prior Office Action filed April 19, 2011 and further explained below, claim 4 is a *proper dependent claim*. Claim 4, despite being a proper claim, has never been examined on the merits. The finality of the Office Action is therefore premature and must be withdrawn. *See* MPEP 706.07(a).

Applicants agree with the Examiner that a multiple dependent claim cannot depend from any other multiple dependent claim. By the objection of claim 4, it appears that the Examiner believes, incorrectly, that claim 4 is a multiple dependent claim. However, claim 4 is not a multiple dependent claim. A multiple dependent claim is "a dependent claim which refers to more than one other claim" in the alternative. MPEP 608.01(n). Claim 4 refers to only one claim -- claim 3. Thus, claim 4 is not a multiple dependent claim by definition. In comparison, claim 3 refers to "claim 1 or 2" in the alternative, and is a multiple dependent claim. *See* MPEP 608.01(n).

Applicants respectfully request that the objection be withdrawn and that claim 4 be examined on the merits. Applicants also respectfully request that the finality of the Office Action also be withdrawn because claim 4, despite always being a proper claim, has never been examined on the merits. Applicants are entitled to have claim 4 examined on the merits as there is no permissible reason for the USPTO to refuse to treat this claim.

Rejections under 35 U.S.C. § 112

Claims 1-7 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner alleges that the feature of "only one radial slot" recited in claim 1 is not described in detail in the specification to convey to a skilled artisan that the inventors invented the claimed device. The Examiner states, "Nothing in the specification described in detail this limitation and/or the criticality of it." Office Action, page 2.

Applicants respectfully disagree. The feature of "only one radial slot" is clearly supported by Figure 4. As explicitly provided in the MPEP §2163.II.A.3.(a):

An applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. See, e.g., *Vas-Cath*, 935 F.2d at 1565, 19 USPQ2d at 1118 ("drawings alone may provide a 'written description' of an invention as required by Sec. 112"); *In re Wolfensperger*, 302 F.2d 950, 133 USPQ 537 (CCPA 1962) (the drawings of applicant's specification provided sufficient written descriptive support for the claim limitation at issue); *Autogiro Co. of America v. United States*, 384 F.2d 391, 398, 155 USPQ 697, 703 (Ct. Cl. 1967) ("In those instances where a visual representation can flesh out words, drawings may be used in the same manner and with the same limitations as the specification.")

In support of this rejection, the Examiner takes the position that "there is no criticality as originally explained in the specification as to why applicant only employed one slot." Office Action, page 6. The Examiner states that the Specification at page 2, lns. 22-23, provides that the slot can be replaced with a plurality of bores, and that "this demonstrate[s] that there is a no criticality as to only one slot." However, there is nothing in this alternative embodiment that detracts from the sufficiency of the disclosure of the single radial slot described throughout the application and illustrated in

Figure 4. The Examiner has considered this alternative embodiment out of context. The present application explicitly states that an arrangement of the plurality of bores "corresponds to the . . . shape and orientation of the slot." Specification at page 2, lns. 22-23. Thus, contrary to the Examiner's contentions, this disclosure of the alternative embodiment further conveys to those skilled in the art that the Applicants had possession of a device having only one slot as claimed.

The Examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. MPEP § 2163 (I)(A). Significantly, the Examiner has not provided any legal support, evidence or reasoning to explain why criticality must be included in the specification in order for a person skilled in the art to recognize in the original disclosure a description of the claimed invention. The application discloses a device having only one slot, as shown in Figure 4. Description is provided throughout the application of a configuration and operation of a device having a single radial slot 3. As further discussed below in response to the section 103 rejection, the specification provides that the device solves the problems of other devices described in the specification at page 3, lns. 3-22, in which a plurality of bores are provided. This disclosure clearly conveys to those skilled in the art that the Applicants envisioned a device having only one slot as recited in the claimed device and fully satisfies the written description requirement. Applicants respectfully request that the rejection be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 1-3, 5-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over German Patent No. DE951119 ("DE119"). Claim 7 was rejected under 35 U.S.C.

§103(a) as being unpatentable over DE119 as applied to claim 1, and further in view of U.S. Patent No. 4,908,983 to Mazur *et al.* ("Mazur").

Independent claim 1 recites:

A device for treating woody plants, comprising a cylindrical injection element equipped with an axial bore; only one radial slot which communicates with the axial bore and whose longitudinal axis is essentially parallel to the axial bore; a fixing element and an element for connecting a reservoir.

The Examiner recognizes that DE119 does not disclose only one radial slot, but asserts that "[i]t would have been obvious . . . to have only one radial slot in the device of DE119, depending on the user's preference to do so based on how much liquid he/she wishes to inject out of the device." Office Action, page 4.

Applicants disagree with the Examiner. The Examiner's assertion of obviousness is fully unsupported. The Examiner has not cited any reference which discloses "only one radial slot." The Examiner's alleged motivation to provide the device of DE119 with a single radial slot is impermissible hindsight. The Examiner's reasoning is taken from Applicants' remarks in the Response to the prior Office Action that was filed on April 19, 2011. In that Response, it was stated:

DE119 and Mazur are like the references described in the present application . . . in which a plurality of outlets are provided. It therefore appears that the person skilled in the art has always aimed at being able to supply, to a woody plant, a large amount of treatment products in as short a time as possible via a multiplicity of outlets or multiple injectors . . . However, the disadvantage of such arrangements is that high application rates of plant treatment products are required and the damage inflicted on the treated woody plant can be significant. *See* the present Specification at page 1, lns. 16-20.

The present application emphasizes that a device having a radial slot solves the problem of the other references that have a multiplicity of outlets:

The problem to be solved is therefore to provide devices for injecting plant treatment compositions which do not suffer from one or more of the above disadvantages.

This problem is solved by the devices for injecting plant treatment compositions, which devices are described hereinbelow.

The invention proposes a device comprising a cylindrical injection element equipped with an axial bore, a radial slot which communicates with the above bore and whose longitudinal axis is essentially parallel to the axial bore; a fixing element and an element for connecting a reservoir.

Specification at page 1, lns. 21-25.

Moreover, a "radial *slot*" having a *longitudinal axis* is recited in claim 1. In contrast, DE119 discloses a radial *bore* 15a. A radial slot is distinguishable from a radial bore; a radial slot has a longitudinal axis, while a radial bore (such as hole 15a of DE119) does not. The present application distinguishes between a slot and a bore, providing that in an alternative embodiment, "a plurality of *bores*" is used in place of "the *slot*." See Specification at page 2, lns. 22-23.

The Examiner has not cited any reference which discloses a "slot" as claimed. DE119 does not disclose a slot. Mazur also does not disclose a slot, and therefore does not cure this deficiency of DE119. Moreover, the Examiner has not provided any rationale as to why a person of ordinary skill in the art would have modified the bores of DE119 so as to arrive at a device having a radial slot, as claimed.

Accordingly, the Examiner has not shown the claimed invention is under 35 U.S.C. 103(a) in view of DE119, alone or in combination with Mazur. Applicants

respectfully request that the rejection of claim 1 and claims 2, 3 and 5-7 which depend therefrom, be withdrawn.

New independent claim 11

Claim 11 recites the features of original claims 1, 3 and 4. The subject matter of claim 4, which includes a feature that the sealing element is a three-way cock, has not been examined on the merits, as discussed earlier. Each of the cited references DE119 and Mazur, alone or in combination, does not disclose a three-way cock. Moreover, as discussed above with respect to claim 1, the cited references do not disclose "a radial slot" as recited in new claim 11. Applicants respectfully request allowance of claim 11.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to be 'A K R'.

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